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Group Art Unit: 2153

Filed: March 15, 2000

Examiner Name: Dinh

Applicant: Smith et al.

Attorney Docket Number: 62-184

TITLE: MOBILE ORIGINATED INTERNET RELAY CHAT

Total Number of Pages in this Submission: 21

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

Transmitted herewith is:
A Reply Brief in the above-identified application (7 Pages X 3)

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED					
	CLAIMS REMAINING AFTER Amendment	HIGHEST # PREV. PAID FOR	# OF EXTRA CLAIMS	RATE	ADDITIONAL FEE
Total Claims	36	50	0	x \$50	\$ 0.00
Independent Claims	6	8	0	x \$200	\$ 0.00
Multiple Dependent Claim(s), if applicable				x \$360	
				TOTAL ADDITIONAL FEE:	\$ 0.00

The Commissioner is hereby authorized to charge any additional fees required under 37 C.F.R. 1.16 or any patent application processing fees under 37 C.F.R. 1.17 associated with this communication, or credit any over payment to Deposit Account No. 50-0687 under Order No. 62-184.

Respectfully submitted,

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Date: June 29, 2006

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Serial No.: 09/525,926
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Examiner: Dinh, Dung C.
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In re Patent Application of:

SMITH

Title: **MOBILE ORIGINATED INTERNET RELAY CHAT**

June 29, 2006

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicant submits herewith the following Reply Brief in triplicate as required by 37 C.F.R. § 1.193(b).

SUMMARY

The Examiner's Answer exemplifies the frustration of the Applicants in the prosecution of the present application: the Examiner continues to allege that it would have been obvious at the time of the invention to combine Burgan, Bunney and WebTV to arrive at the claimed invention.

Section 103 rejections combining Burgan, Bunney and WebTV

The Examiner indicated that the obviousness rejection of claims 1-5, 11, 12, 20-27, 31, 39-45 and 50 relies on an alleged inherency within the relied on prior art. In particular, the Examiner argued that WebTV discloses a proxy that can handle MODE commands, with the system inherently having the capability to send a ghosting command (See Office Action dated June 20, 2005, page 4). However, inherency is not applicable in a rejection under §103. In re

Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). The Examiner has FAILED to address the fact that the Examiner's rejection is improper since relying on inherency.

Under the doctrine of necessary inherency, anticipation may be established when a single prior art reference fails to disclose the claimed invention ipsissimis verbis, but the natural and invariable practice of the reference would necessarily inherently meet all the elements of the claim. See, e.g., Verdegaal Bros., Inc. v. Union Oil Col. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 245 (Fed. Cir. 1985); Ethyl Molded Products Co. v. Betts Package Inc., No. 85-111 1032 (D.C.E.D. Kent. 1988). The doctrine of inherency is available only when the inherency can be established as a certainty; probabilities are not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Chandler, 254 F.2d 396, 117 USPQ 361 (CCPA 1981); Ethyl Molded Prod. Co. at 1032.

The Examiner's Answer further compounded the improper use of inherency with an allegation that Bunney inherently disclosed claimed features (see Examiner's Answer, page 13). However, as Applicants previously pointed out with the Examiner allegation that WebTV inherently disclosed claimed features, inherency is not applicable in a rejection under §103. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The Examiner has FAILED to address the fact that the Examiner's rejection of Applicants' claimed features is improper at its core since relying on inherency.

Claims 1-5, 11, 20-27 and 39-45 reire a non-Internet Relay Chat program that is adapted to be executed by a wireless mobile device used to communicate with a standard IRC server.

Applicants argued that only one of the three cited references, Burgan, used to reject claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 has any applicability to unique problems associated with wireless mobile devices. However, none of Burgan's mobile wireless devices have any access to the

Internet (See Fig. 1), much less rely on a wireless Internet gateway server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50. Thus, the Examiner has STILL failed to show a single reference that discloses or suggests using a wireless Internet gateway server (which is NOT disclosed by ANY of the Examiner's relied on references) to allow a wireless mobile devices that relies on a non-Internet Relay Chat program to participate in an IRC session.

The Applicants' Appeal Brief argued that only one of the three cited references, Burgan, used to reject claims 1-5, 11, 12, 20-31, 39-45, 47, 49 and 50 has any applicability to unique problems associated with wireless mobile devices. An evaluation of obviousness must be undertaken from the perspective of one of ordinary skill in the art addressing the same problems addressed by the applicant in arriving at the claimed invention. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 23 USPQ 416, 420 (Fed. Cir. 1986), cert. denied, 484 US 823 (1987). Thus, the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claimed invention. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). Nothing within Bunney nor WebTV suggests applicability of any teachings to problems associated with wireless mobile devices, much less to wireless mobile devices that conventionally lack the ability to participate in an IRC session.

The Examiner responded to the Applicants' "argument is not persuasive because the problem being solved is not unique to wireless mobile devices. The problem and solution is applicable to a broader range of devices – namely permitting a limited capability device the ability to participate in an IRC chat session (see Examiner's Answer, page 11). The Applicants respectfully disagree.

Applicants' claims are specifically directed toward wireless mobile devices NOT generically a limited capability device. Many wireless mobile devices that conventionally lack the ability to participate in IRC do not have the access to an Internet connection, such as Bunney's device. Moreover, wireless mobile devices that conventionally lack the ability to participate in IRC are very basic devices, i.e., have a very simply operating system, a very limited amount of memory to store and execute programs, etc. However, WebTV's device is a

rather sophisticated device that has the ability to connect to the Internet, a rather sophisticated operating system that can execute rather complex applications, etc. Bunney's devices has the ability to participate in an IRC, thus contains an operating system sophisticated enough to execute an IRC program, connect to an IRC servers, etc. Thus, WebTV's device and Bunney's device are NOT addressing the same problem of adding IRC capability to a mobile wireless device that conventionally lacks the ability to participate in an IRC.

Moreover, the Examiner has STILL failed to show why it would have been obvious to modify Burgan to connect to any outside network, much less to participate in an IRC. Burgan's invention is specifically directed toward chat sessions that occur completely within a telephone network (see Fig. 1). The Examiner acknowledged that Burgan fails to "disclose providing Internet Relay Chat service" (See Examiner's Answer, page 5). However, nothing within the cited prior art provides a suggestion or incentive to modify Burgan to connect to the Internet, to connect to a chat proxy server or to connect to a standard Internet Relay Chat server, much less all of a connection to the Internet, a chat proxy server and a standard Internet Relay Chat server. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). The Examiner has STILL failed to address why one of ordinary skill would have modified Burgan conveniently to arrive at the claimed features.

Moreover, the Applicants contend that Burgan in fact TEACHES AWAY from connecting a mobile wireless device to an IRC session. Internet access was prevalent and available for devices at the time of Burgan's invention (see Fig. 1 for a computer, a wireless PDA and a wireless cellular phone). However, instead of using a broader network, i.e., the Internet, to potentially connect to a much broader range of participants, such as IRC participants, which both existed at the time of the invention, Burgan chose to implement the invention within a closed telephone network having NO access to the Internet. "A prior art reference must be considered in its entirety, i.e., as a whole, including

portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-132 (Rev. 3, Aug. 2005) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984))(emphasis in original).

The Examiner's Answer acknowledged that Burgan fails to disclosed that his wireless gateway server is a wireless Internet gateway (See Examiner's Answer, page 6). However, the Examiner alleged that it is well known in the art to provide a wireless Internet gateway for connecting a wireless mobile device to an Internet, as allegedly shown by Ramasubramani in Fig. 1, item 106 and at col. 1, lines 30-37 (see Examiner's Answer, page 6). Ramasubramani is NOT relied on to reject claims 1-5, 11, 12, 20-27, 31, 39-45 and 50. The rejection of claims 1-5, 11, 12, 20-27, 31, 39-45 and 50 is based on the allegedly obvious modification of Burgan with the disclosure of Bunney and WebTV. Thus, the Examiner is now relying on a new rejection that relies on Ramasubramani to reject claims 1-5, 11, 12, 20-27, 31, 39-45 and 50 that was not made during prosecution.

Moreover, the Applicants are not contesting that a wireless Internet gateway is used for connecting a wireless mobile device to an Internet. However, as discussed above there is no suggestion within the prior art to modify Burgan's chat system that completely operates within a telephone network to additionally include a wireless Internet gateway. Adding a wireless Internet gateway to system would only allow Burgan's devices access to the Internet (which is not an obvious modification as discussed above). Burgan's entire system would have to be modified from routing chat messages over a telephone network to instead route chat messages through a wireless Internet gateway. Hence, since the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01, page 2100-132 (Rev. 2, May 2004) (citing *In re Ratti*, 123 USPQ 349 (CCPA 1959).

The Examiner alleges that IRC chatting requires access to the Internet; hence, it is obvious that Burgan system as modified would have a

wireless Internet gateway (see Examiner's Answer, 6). However, the Examiner's rejection uses reverse logic. The Examiner's premise starts with an allegedly obvious modification of adding IRC capability to Burgan and then uses obviousness to add whatever elements are necessary to arrive at the claimed features. However, IRC theoretically does not require an Internet connection, i.e., would not necessarily require an wireless Internet gateway, with a proxy server fulfilling communications to the Internet for participation in an IRC session, i.e., such as that used by WebTV.

All rejected claims 12, 31 and 50 require a system and method of ghosting a channel of an Internet Relay Chat group through a non-IRC program associated with a mobile device.

The Examiner alleges that WebTV clearly discloses the proxy can handle MODE commands. However, the Examiner has STILL failed to show any prior art reference that uses a non-IRC program associated with a mobile device for ghosting. The Examiner relies on Burgan to disclose a non-IRC program (see Examiner's Answer, page 4). However, nothing within the cited prior suggests modifying Burgan's chat system to participate with IRC, much less to further have the ability to perform ghosting, all of which are being conducted through a non-IRC program, as recited by claims 12, 31 and 50.

Moreover, the Examiner relies on WebTV to disclose MODE commands, with the Examiner is assuming that a device that supports MODE commands supports ALL MODE commands, which is not disclosed by the reference. A person saying a few words in a foreign language technically can say they speak a foreign language. However, speaking a foreign language is different than being fluent in a foreign language. WebTV discloses using MODE commands, however WebTV fails to disclose being "fluent" in MODE commands, i.e. fails to disclose the ability to perform ALL MODE commands such as ghosting. The ability to participate in an IRC chat session with MODE commands does not require the ability to perform ghosting.

Moreover, as discussed above, the cited prior art fails to disclose or suggest a reason to modify Burgan's to participate with an IRC chat session, much less to modify Burgan with the ability to perform ghosting, much less the

ability to perform ghosting of a channel of an Internet Relay Chat group through a non-IRC program associated with a mobile device, as recited by claims 12, 31 and 50

Conclusion

Applicants have prosecuted this application in good faith, but continues to be faced by the current Examination team with 103 rejections, combining references that fail to teach a key feature of the invention and allegedly once combined teach the key feature. As a result, Applicants have no choice but to Appeal the unfair and stubborn interpretations of unrelated prior art by the Examiner in the present application.

For the reasons set forth above, the rejections of claims 1-21 are improper and should be reversed. The Applicants therefore respectfully request that this Appeal be granted and that the rejections of the claims be reversed.

Respectfully submitted,



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